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3 RECORD OF ORAL HEARING
4 UNITED STATES PATENT AND TRADEMARK OFFICE

5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* KATRIN REISINGER
11

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13 Appeal 2009-014551
14 Application 09/917,541
15 Technology Center 3600
16

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18 Oral Hearing Held: August 17, 2010
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22 Before JOHN A. JEFFERY, HUBERT C. LORIN AND
23 JOSEPH A. FISCHETTI, Administrative Patent Judges.
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25
26 ON BEHALF OF THE APPELLANT:
27

28
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1 The above-entitled matter came on for hearing on Tuesday,
2 August 17, 2010, commencing at 9:30 a.m. at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, 9th Floor, Hearing Room A, Alexandria,
4 Virginia, before Jan M. Jablonsky, notary public.

5 THE USHER: Calendar Number 2009-014551, Mr.
6 Weichselbaum.

7 JUDGE JEFFERY: Good morning. You have 20 minutes and
8 you can begin whenever you're ready.

9 MR. WEICHSELBAUM: Okay. Give me just a minute.
10 There's a lot of paperwork in this file. Okay. I really don't have that much
11 to say. I'd just like to comment on the prior art a little bit. Hopefully, I can
12 clarify some of the issues that have been discussed.

13 Appellant discussed the teaching in Leon in quite a number of
14 places in the briefs, particularly the teaching in paragraph 13 that describes
15 the initialization procedure. And that teaching basically describes an
16 initialization procedure that takes place at the factory before that metering
17 device has left the factory. They prepare for this initialization by placing a
18 certain bit in a state. They initialize the device, then this bit is placed in
19 another state so that it cannot be initialized again, and it leaves the factory.

20 Now, the Examiner has mentioned another teaching in Leon
21 where it teaches an input device that can be a switch, a key, and that input
22 device is totally unrelated to the initialization. That's simply related to
23 printing out an item of indicium. Now, the Examiner, he focuses on this
24 input element, which is unrelated to the initialization. It just activates the
25 printing of the indicium, and then he moves to the teaching in Vu. And

1 appellant submits that the teaching in Vu has nothing to do with the printing
2 out of an indicium. Also, it has nothing to do with an initialization
3 procedure.

4 Vu teaches a cryptographic key, and the problems addressed in
5 Vu are unrelated to the problems that exist in the device of Leon. Vu is
6 concerned with a computer where all kinds of programs can be downloaded
7 into the computer and you don't know what types of processes might be
8 observing other processes going on. And, so, it can create a problem if the
9 cryptographic processing is done on that computer, because then maybe
10 these other processes can observe that processing.

11 So Vu teaches, listen, we're going to do this processing of the
12 cryptographic key in an external device. And some type of smart card, that's
13 the prior art, and Vu comes up with some type of emulation on another
14 external device. The problem that Vu addresses, it's just non-existent in the
15 teaching of Leon which is not a computer device, which will have all these
16 different kinds of programs running on it, and which is initialized at the
17 factory, which is a secure environment, where they know exactly what's on
18 that machine.

19 So in -- let's see. I'm referring to the Brief that was filed on
20 March 24th of '05 where appellant previously stated that there's just no
21 motivation or valid basis for combining Leon and Vu other than a hindsight
22 reconstruction. Appellant can't see any other reason for combining those
23 references.

24 JUDGE LORIN: All right, counsel. I want to understand your
25 position a little more clearly.

1 MR. WEICHSELBAUM: Okay.

2 JUDGE LORIN: Your claim calls for a security module being
3 programmed to check whether authorization is present and would prevent
4 the initialization of said mailing machine without authorization.

5 MR. WEICHSELBAUM: Right.

6 JUDGE LORIN: That's the last clause in your Claim 1. Are
7 you saying Leon does not do that?

8 MR. WEICHSELBAUM: That's right.

9 JUDGE LORIN: Because, I mean, there's no dispute that Leon
10 discloses a security model of this they called an SMD. And that performs
11 initialization, the SMD. Correct?

12 MR. WEICHSELBAUM: This is true, yes.

13 JUDGE LORIN: And my understanding is during the
14 initialization that occurs in the SMD, there is an authorization that's going
15 on. Is that not true?

16 MR. WEICHSELBAUM: Appellant doesn't follow that line of
17 reasoning. Appellant's device is an external device that provides
18 authorization, whereas, in Leon there is no separate device that provides
19 authorization. It's just the source of data itself, which is even more pertinent
20 with respect to Claim 18 where a separate source of data is actually recited
21 in the claim.

22 JUDGE LORIN: Well, where is the authorization occurring in
23 Leon? Isn't it occurring within the SMD?

24 MR. WEICHSELBAUM: If you look at it that way, I mean,
25 Leon --

1 JUDGE LORIN: I mean take a look, counsel, at Figure 5B.

2 MR. WEICHSELBAUM: Right.

3 JUDGE LORIN: 5B, and this Figure shows what's occurring
4 with regard to the SMD, which would be your security module.

5 MR. WEICHSELBAUM: Right. But, again, that's not a
6 removable authorization device that's operatively connected to the mailing
7 machine. That actually is part of the mailing machine.

8 JUDGE LORIN: So your argument isn't that the operation that
9 you claim doesn't actually occur. Your argument is that you have a
10 removable authorization device that performs the operation that is occurring
11 in Leon within the SMD. All you've done then is take the authorization
12 operation and you've placed it on a removable authorization device.

13 MR. WEICHSELBAUM: Well, it's -- I'm sorry.

14 JUDGE LORIN: Is that not true? I mean I'm trying to
15 understand your position.

16 MR. WEICHSELBAUM: It's true, but appellant believes that
17 there's more to it than that, because in Leon the authorization is part of the
18 data stream. It comes from that source. It comes from the source of data
19 itself; whereas, appellant's removable authorization device, it's separate from
20 that source of data. It's an independent thing and it's even -- well, appellant
21 believes -- it's more clear in Claim 18 where that source of data appears in
22 the claim separately.

23 So it's more clear that that source of data and that this
24 initialization are separate things. In Claim 1, yes, the language is the
25 removable authorization device, so that's how they focused to make the

1 distinction in that claim. So there is a difference, but when you focus on the
2 claim language, I would say you're pretty much correct.

3 JUDGE FISCHETTI: Counsel, doesn't Vu make up for that
4 deficiency? If I see right, they talk about, I guess it's -- let's see. Column 4,
5 they talk about this token.

6 MR. WEICHSELBAUM: Hm-hmm.

7 JUDGE FISCHETTI: That may include any tech removable,
8 physical storage device, such as magnetic strip, PCMCIA card, floppy, CDR,
9 et cetera, et cetera. So would that not make up for the difference in what
10 Leon is apparently failing to teach?

11 MR. WEICHSELBAUM: No, sir, because it's a totally
12 different application. The way that Vu is using this token, it's totally
13 unrelated to anything that's going on in Leon. I mean Vu is saying, listen.
14 We don't want to have this cryptographic processing going on in a computer
15 device, so we're going to provide this other device, this separate device, this
16 token, where this cryptographic processing is going to take place. And,
17 therefore, this processing is going to be secure and other processes running
18 on the computer are going to be able to access it -- or, excuse me, are not
19 going to be able to access it.

20 So appellant's position is just because Vu teaches some type of
21 a removable device, how does that suggest modifying Leon when what's
22 going on in Leon really is totally unrelated to what's going on in Vu; and, the
23 concerns that Vu is addressing are really not applicable to what's going on in
24 Leon.

25 JUDGE FISCHETTI: Such as?

1 MR. WEICHSELBAUM: Such as, as I had mentioned, Vu
2 teaches. Listen, when you have a computer, and that's the first difference.
3 Vu relates to a computer where there's a lot of programs and processes
4 running, and one process, if it's the malicious process, can access things that
5 would be preferred to be kept secret, like this cryptographic processing.

6 So that's a problem in Vu. That's not going on in Leon, because
7 first of all, it's not a computer system. It's a dedicated mailing machine, or
8 franking machine, which is only going to have programs doing certain things
9 addressed to the functions of that mail machine, pertinent are not going to be
10 constantly downloaded onto that mailing machine. And, furthermore, the
11 initialization that's going on in Leon, it's only going on one time, and it's in
12 the factory.

13 And that's a very secure environment. And at the factory, they
14 know exactly what's on that machine and there's no risk of some other
15 malicious process being on there. And, I think if you wanted to kind of
16 extend that logic, I mean, the risk that some program could be loaded onto
17 this mailing machine at a future date, I don't really see it and I don't think it's
18 evident from the teachings in the prior art that that could happen.

19 JUDGE LORIN: Counsel, I want to focus on Claim 1. I'm still
20 having some problems understanding the position. You have a mailing
21 machine with a controller, a security module, and a program memory, and a
22 removable authorization device in four pieces. The security module, the
23 way it's worded in the claim -- and we've already gone through this -- being
24 programmed to check whether authorization is present and preventing

1 initialization without authorization, if you just set that alone, is that not met
2 by the security module in Leon?

3 That alone, I mean, just looking at that particular piece, that
4 module, the way you have worded it. Does it not function exactly the same
5 as the security module in Leon?

6 MR. WEICHSELBAUM: If you just focus on that paragraph I
7 would have to agree. I certainly can't give a credible argument against that.
8 But when you combine it with the removable authorization device,
9 appellants feel that what's being defined there is different.

10 JUDGE LORIN: Okay. Now let's go to that point. When I
11 read the claim, how is it that this removable authorization device, how is it
12 that that operates with the security module in the way you've claimed it
13 here? You have a removable authorization device being operationally
14 connected to said mailing machines and configured for being interrogated by
15 the mailing machine. How would that have anything to do with the security
16 module?

17 MR. WEICHSELBAUM: Because the authorization device,
18 obviously, provides authorization; and, in the next frame or the next
19 paragraph the security module is checking whether that authorization is
20 present.

21 JUDGE LORIN: Where does it say that? This is an apparatus
22 claim.

23 MR. WEICHSELBAUM: I'm sorry?

24 JUDGE LORIN: This is an apparatus claim.

25 MR. WEICHSELBAUM: That's correct.

1 JUDGE LORIN: Not a process claim, but nevertheless, where
2 does it say that?

3 MR. WEICHSELBAUM: I mean you have a point; it could be
4 more clear.

5 JUDGE LORIN: All right. Okay. I understand your position
6 now with the apparatus claim. Now, let's go to the method claim, and to be
7 frank, the Brief and the answer seemed to focus almost entirely on the
8 apparatus claim. But I find that some of the discussion involving the
9 apparatus claim don't really apply to the method claim. For example, you
10 said, and you just did it now, that the initialization occurs in the factory.

11 MR. WEICHSELBAUM: Right.

12 JUDGE LORIN: But I don't see this claim precluding the fact
13 that the initialization can appear ineffective.

14 MR. WEICHSELBAUM: Oh. I think maybe I didn't make my
15 comments clear. The comments that I was making, they really weren't
16 related to the claims. They were related to what one of ordinary skill in the
17 art would be taught by the teaching in Leon and Vu, and like the point I was
18 trying to make was that in Leon this initialization is done at the factory.
19 And, because of that, the concerns of Vu are not applicable.

20 That, also combined with the fact that Vu addresses problems
21 that are going to occur in a computer system, whereas, Leon, it's not a
22 computer system. It's a dedicated mailing machine. So I'm saying the
23 problems that Vu addresses are just of no concern in the mailing machine or
24 in the device of Leon.

1 JUDGE LORIN: No. Thank you, counsel. I appreciate that. I
2 did not understand, but I understand your position better now. I appreciate
3 that.

4 MR. WEICHSELBAUM: Thank you.

5 JUDGE LORIN: I appreciate that. Now, going back to another
6 point in the method claim, we were just discussing this removable
7 authorization module as being a distinction over the prior art. But, in the
8 method claim I don't see any mention of a removable authorization device.
9 So why would that position matter with regard to the method claim? And
10 the Brief is --

11 MR. WEICHSELBAUM: I --

12 JUDGE LORIN: No. I'm sorry, counsel.

13 MR. WEICHSELBAUM: I would have to agree with you.

14 JUDGE LORIN: I think our difficulties are not with the way
15 you've expressed your position. The difficulties we're having is when we
16 look at the claim .

17 MR. WEICHSELBAUM: Right.

18 JUDGE LORIN: We're having a hard time seeing what you're
19 saying, worded as you say they are.

20 MR. WEICHSELBAUM: You're absolutely right. If I could,
21 I'd just like to cancel the method claims and withdraw them from the appeal.

22 JUDGE LORIN: Well, you wouldn't do that with us. That's
23 what you would do with the Examiner.

24 MR. WEICHSELBAUM: Okay.

1 JUDGE LORIN: But, I mean we're just interested in
2 understanding your position and whether the Examiner has presented a
3 prima facie case or not. If it comes to that, that's something you would raise
4 with the Examiner when it goes back to prosecution. But, okay. Thank you
5 counsel, for your comments.

6 JUDGE JEFFERY: The only other question I have is really
7 going back, and we've discussed this before. But I thought I just want to
8 clarify in my mind, going back to Figure 5B of Leon, where you have the
9 initialization that occurs at the factory kind of thing.

10 MR. WEICHSELBAUM: Hm-hmm.

11 JUDGE JEFFERY: And then you have some steps before you
12 get to the initialized state, which is step 540 there. It says, "SMB transitions
13 to initialized state." And then prior to that in steps 524 and 528, and so on,
14 there's some kind of validation that goes on there. And it sounds like to me
15 that you would agree that that's an authorization, at least in light of the scope
16 and breadth of the term. I mean there's some type of validation that's
17 occurring there.

18 So, yes, just wanted to clarify that. The only other point, going
19 back to Claim 1, that I'd like to make is, you know, the last clause calls for
20 preventing an initialization of the mailing machine without authorization.

21 MR. WEICHSELBAUM: I'm sorry. Could you give me just --

22 JUDGE JEFFERY: And I understand your position regarding
23 the removable authorization.

24 MR. WEICHSELBAUM: I'm sorry. Could you repeat that? I
25 was looking at the case.

1 JUDGE JEFFERY: No. I'm going back to Claim 1 here, and
2 just noting the last clause that we've discussed for preventing an
3 initialization of said mailing machine without authorization. And then I
4 understand your point regarding the removable authorization device, the
5 pointing being made that there's no connection between the removable
6 authorization device and that last clause. I mean is there anything
7 precluding a different kind of authorization.

8 I guess that's my question here. I understand that the removable
9 authorization device is intended to authorize, if you will, but the security
10 module could perhaps authorize in a different way or a different fashion. Is
11 there anything precluding that? I guess we've covered this ground already.

12 I don't want to belabor the point, but it strikes me as indicated
13 that the removable authorization device and its functionality doesn't seem to
14 be tied to the authorization that's prevented, the authorization that's required
15 at the end of the claim. So I guess the point being that there needs to be
16 some sort of connection here between the two.

17 MR. WEICHSELBAUM: You're right. It could have been
18 better worded, but that being said, the claim does have that removable
19 authorization device which is not taught in Leon and which we believe is
20 certainly not suggested by Vu in combination with Leon.

21 JUDGE JEFFERY: Okay. Anything further?

22 JUDGE LORIN: No.

23 JUDGE JEFFERY: Okay, counsel. I think that will do it.
24 Thank you very much.

25 Whereupon, at 9:53 a.m., the proceedings were concluded.